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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/613,154 06/30/00 LARSON

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| EXAMINER |
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| AVILA, S |              |
| ART UNIT | PAPER NUMBER |

3617  
DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/613,154**

Applicant(s)  
**Larson et al**

Examiner  
**Stephen Avila**

Art Unit  
**3617**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/30/00
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. The protest filed December 23, 2000 has been fully considered. With respect to the art cited in the Protest, specifically in section III B of the Protest, the patented claims define over the listed art.

2. Applicant's amendment to the application by adding the following to the specification is improper:

"This Application is a Continuation-in-Part of and incorporates by reference Application Serial Number 29/078494, filed October 27, 1997 and issuing as United States Patent No. Des. 409,972 of May 18, 1999, all of which are commonly owned and assigned."

Note that in Applicant's response to the Protest filed February 23, 2001, Applicant points to *Vas-Cath, Inc. V. Mahurkar*, 19 USPQ 2d 1111. It is stated that "the Court found that these specific limitations were still sufficiently disclosed in the original design application drawings." However, the claims in the '350 patent are not supported by the design drawings. Specifically, with respect to claim 33, "for a performer using a water sport implement and being towed behind a vessel while maintaining the stability of the vessel, the vessel having a bow, a stern, opposing sides extending from the bow to the stern, and an operator station located amidships between the opposing sides" (lines 1-6) and "for fitting to the sides across the beam of the vessel at a point amidships substantially above the level of the operator station" (lines 7-15) are not supported in the design drawings.

3. Applicant's amendment to Incorporate by Reference the Application for the '972 Design Patent appears to introduce new matter. No new matter may be introduced into the reissue

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application. The seven figures contained in the '972 Design Patent were not contained in the '350 patent and are new matter.

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The errors relied upon including priority to Application 29/078494 is not proper.

5. Claims 1-49 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

7. While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

8. Direct telephone inquiries concerning this communication to **Stephen Avila, at telephone number (703) 308-2578.**


The fax number for Technology Center 3600 is (703) 305-7687. Fax responses are encouraged, especially after final rejections.

The examiner's supervisor, Joseph Morano, can be reached at (703) 308-0320.

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Inquiries of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at (703) 308-1113.

AVILA:sa  
April 23, 2001



*Stephen Avila*  
*Primary Examiner*  
*Art Unit 3612*

4/23/01